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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,024	03/17/1999	ASGEIR SAEBO	CONLINCO-036	3480

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/29/2001

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/271,024

Applicant(s)

SAEBO ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of the amendments and remarks submitted September 13, 2001 is acknowledged.

Claim Rejections 35 U.S.C. – 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


2. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. (WO 97/18320, IDS) for reasons set forth in the prior office action.

3. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsen et al. (US 5,885,594) in view of Cook et al. (US 5,554,646, No. 4 in the IDS of April 13, 2000), further in view of Chin et al. (IDS April 13, 2000, 39) for reasons set forth in the prior office action.

4. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann et al. (WO98/49129, No. 25 in the IDS of April 13, 2000) in view of Cook et al. (US 5,554,646, No. 4 in the IDS of April 13, 2000) and further in view of Chin et al. (IDS April 13, 2000, 39) for reasons set forth in the prior office action.

Response to the Arguments

Applicants' arguments submitted September 13, 2001 have been fully considered, but are not persuasive for reasons discussed below.

 Applicants have miss-characterized Cain's teaching. Specifically, Cain et al. have characterized all the fatty acid through gas chromatography and have identified the CLA. For

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example, in example 6, it state "The fatty acid composition of the product, as determined by FAME GC, contained 63.8% CLA of which 48.9% was the cis 9, trans 11 isomer and 51.1 % was the trans 10, cis 12 isomer." See page 16, lines 17-21. The rest of the fatty acids are not CLA . The CLA is composed entirely of cis 9, trans 11 isomer and trans 10, cis 12 isomer. (48.9% + 51.1 % = 100%). No other CLA isomer was present.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., novel method) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, applicants have not shown the criticality of the 1% less amounts of 11, 13; 8, 10, or trans trans isomers to the quality of the CLA composition in terms of bioactivity or other properties.

6. The assertion that Cain's CLA would be similar to those disclosed by Sugano is not convincing. Particularly, Cain's analytical results do not shown any of 11, 13, 8, 10, or trans trans isomers. Further, one of ordinary skill in the art would have not been surprised by the differences between Cain and Sugano, in view of process employed by Cain and Sugano. The processes employed by Cain and Sugano are different in terms of concentration of the starting materials, the reaction time and the process of obtaining the final products. See, particularly the example 6 at page 16 in Cain and pages 521-522 in Sugano.

Applicants' remarks regarding the rejection based on Nilsen et al. in view of Cook et al. and further in view of Chin et al. are not persuasive. Particularly, isolation and purification of a known organic compound is within the skill of artisan. Chin is cited to show that person of

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ordinary skill in the art possess the skill of preparing/or isolating the pure single isomer employed herein. See, page 697, left column therein. Particularly Chin shows that the isomers are separatable. Further, the quantity of purified compounds is not relevant since the instant claimed composition would read on any amount of compounds.

Applicants' conclusion that Nilsen et al. is silent about other isomer and therefore is not excluded from the employing other isomer is logically incorrect. If Nilsen et al. is silent about the other isomer, it met the limitation of less than 1% of that isomer because no other isomer is required by Nilsen et al. Regarding the particularly percentage of each of the active isomers, note the particular percentage merely make the claimed invention differ from the prior art in degree, not in kind. It is obvious to one of ordinary skill in the art to make such variation, absent evidence to show an unexpected benefit of the particular percentage.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, or motivation is found both in the references themselves and in the knowledge generally available to one of ordinary skill in the art. Specifically, Neilsen et al. teaches acyglycerol composition wherein the fatty acid moiety may be 9, 11 or 10, 12 CLA, Cook et al. teaches that 9, 11 and 10, 12 CLA employed herein are known to be beneficial for animal health. Column 1, lines 51-57. Further, note all the isomers herein are

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known. See column 4, lines 48-59 in Cook et al. Therefore, it is prima facie obvious to make an acyglycerol wherein the fatty acid moiety is a combination of two known CLA isomers because all the isomers are known to be similarly useful.

Applicants' remarks regarding the rejection based on Timmermann et al. in view of Cook et al. and further in view of Chin et al. are not persuasive. Particularly, as stated above, isolation and purification of a known organic compound is within the skill of artisan. Chin is cited to show that person of ordinary skill in the art possess the skill of preparing/or isolating the pure single isomer employed herein. See, page 697, left column therein. Particularly Chin shows that the isomers are separable.

The assertion that there is no motivation to combine the references is not persuasive for reasons discussed above.

The instant claims are directed to a composition comprising old and well-known compounds. The motivation to make such composition is clear and obvious to one of ordinary skill in the art as shown in the cited references. The attempt to distinguish the instant claim from the prior art by limiting the amounts of other isomers or undesirable impurity is not probative particularly because an composition does not have limitation of quantity (not percentage) to its components and the isolation and purification of each ingredients herein is considered within the skill of artisan and has been demonstrated as such (Chin et al.).

A product by a process as disclosed in example 1 in the specification would be favorably considered. Further evidence may be required to show the difference between the products herein and those disclosed by Cains et al. since the processes involved are quite similar to each other.

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Nothing unobvious is seen in the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Shengjun Wang

AU 1617

Nov. 26, 2001

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200